

REMARKS

This is a full and timely response to the non-final Office Action of October 26, 2005. Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this First Response, claims 1-22 are pending in this application. The specification and claims 1, 9, 13, 18, 20, and 21 are directly amended herein, and claims 20-22 have been allowed. Furthermore, amendments to the specification have been submitted herewith. It is believed that the foregoing amendments add no new matter to the present application.

Response to Specification Objection

The specification is objected to due to an alleged informality. Applicant asserts that the Specification has been amended herein thereby mooting the objection. Accordingly, Applicant respectfully requests that the objection to the specification be withdrawn.

Response to Claim Objection

Claim 21 is objected to due to an alleged informality. Applicant asserts that claim 21 has been directly amended herein thereby making the objection to this claim moot. Accordingly, Applicant respectfully requests that the objection to claim 21 be withdrawn.

Response to §102 and §103 Rejections

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. Furthermore, the Federal Circuit has stated that “(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

Claim 1

Claim 1 is rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Nagai* and under 35 U.S.C. §103 as purportedly being unpatentable over *Rao* in view of *Nagai*. Claim 1 reads as follows:

1. A cartridge storage system comprising:
a movable component;
a removable nonvolatile memory component (RNMC) residing on a first printed circuit board, the RNMC storing operational data indicative of an operational history of the movable component when the RNMC resided on a second printed circuit board; and
logic configured to operate the movable component in response to the cartridge storage system detecting an error based upon the operational data stored in the RNMC residing on the first printed circuit board. (Emphasis added).

Applicant respectfully asserts that *Nagai* fails to disclose and the combination of *Rao* and *Nagai* fails to teach at least the features of claim 1 highlighted hereinabove.

In this regard, the Office Action states that *Nagai* discloses each feature of claim 1 and that the combination of *Rao* and *Nagai* teaches each feature of claim 1. However, claim 1 has been amended herein to include “logic configured to operate the movable component in response to the cartridge storage system detecting an error based upon the operational data stored in the RNMC residing on the first printed circuit board.”

Applicant respectfully asserts that *Nagai* fails to disclose and the combination of *Rao* and *Nagai* fails to teach such features.

For at least the above reasons, Applicant respectfully submits that *Nagai* is inadequate to anticipate each feature of claim 1 and the combination of *Nagai* and *Rao* is inadequate to teach each feature of claim 1. Thus, the 35 U.S.C. §102 and the 35 U.S.C. §103 rejections of claim 1 should be withdrawn.

Claims 2-8

Claims 2, 4-6, and 8 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Nagai*. Further, claim 7 presently stands rejected under 35 U.S.C. §103 as purportedly unpatentable over *Nagai*, and claim 3 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Rao* in view of *Nagai*. Applicant submits that pending dependent claims 2-8 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-8 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 9

Claim 9 is rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Nagai* and under §35 U.S.C. 103 as purportedly being unpatentable over *Rao* in view of *Nagai*. Claim 9 reads as follows:

9. A cartridge storage system comprising:
 a cartridge access device;
 a removable nonvolatile memory component (RNMC) residing on a first printed circuit board, the RNMC storing operational data indicative of an operational history of the movable component when the RNMC resided on a second printed circuit board; and
means for operating the movable component in response to the cartridge storage system detecting an error based upon the operational data stored on the RNMC residing on the first printed circuit board.
 (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1, Applicant respectfully asserts that *Nagai* fails to disclose and the combination of *Nagai* and *Rao* fails to teach at least the features of claim 9 highlighted hereinabove. Thus, the 35 U.S.C. §102 and the 35 U.S.C. §103 rejections of claim 9 should be withdrawn.

Claims 10-12

Claim 11 presently stands rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Nagai*, and claim 12 presently stands rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Rao* in view of *Nagai*. Furthermore, no specific rejection is provided in the Office Action with respect to claim 10. However, in a telephone conversation with the Applicant's undersigned agent and attorney on January 4, 2006, the Examiner indicated that claim 10 is rejected for reasons similar to those provided for claim 8. Applicant submits that pending dependent claims 10-12 contain all features of their respective independent claim 9. Since claim 9 should be allowed, as argued hereinabove, pending dependent claims 10-12 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 13

Claim 13 is rejected under 35 U.S.C. §102(b) as being anticipated by *Nagai* and under 35 U.S.C. §103 as purportedly being unpatentable over *Rao* in view of *Nagai*.

Claim 13 reads as follows:

13. A cartridge management method comprising:
 - automatically transporting a cartridge from one location within a cartridge storage system to another location within the cartridge storage system;
 - storing operational data related to the transporting to a removable nonvolatile memory component (RNMC) coupled to a first printed circuit board;
 - replacing the first printed circuit board with a second printed circuit board;*
 - coupling the RNMC to the second printed circuit board; and*
 - automatically determining, based upon the operational data, the location of the cartridge.* (Emphasis added).

Applicant respectfully asserts that *Nagai* fails to disclose and the combination of *Rao* and *Nagai* fails to teach at least the features of claim 13 highlighted hereinabove.

In this regard, the Office Action states that *Nagai* discloses each feature of claim 13 and that the combination of *Rao* and *Nagai* teaches each feature of claim 13. However, claim 13 has been amended herein to include “replacing the first printed circuit board with a second printed circuit board,” “coupling the RNMC to the second printed circuit board,” and “automatically determining, based upon the operational data, the location of the cartridge.” Applicant respectfully asserts that *Nagai* fails to disclose and the combination of *Rao* and *Nagai* fails to teach such features.

For at least the above reasons, Applicant respectfully submits that *Nagai* is inadequate to anticipate each feature of claim 13 and the combination of *Nagai* and *Rao* is inadequate to teach each feature of claim 13. Thus, the 35 U.S.C. §102 and the 35 U.S.C. §103 rejections of claim 13 should be withdrawn.

Claim 18

Claim 18 has been indicated as allowable by the outstanding Office Action if such claim is rewritten in independent form to include the limitations of its respective base claim and any intervening claims. Claim 18 has been rewritten in independent form by adding features from its respective independent claim 13. Applicant asserts that claim 18, in its present form, is allowable and respectfully requests that the objection to this claim be withdrawn.

Claims 14-17 and 19

Claim 14 and 15 presently stands rejected in the Office Action under 35 U.S.C. §102 as allegedly anticipated by *Nagai*, and claims 16 and 17 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly unpatentable over *Rao* in view of *Nagai*. Furthermore, claim 19 presently stands objected to as being dependent upon a rejected base claim. Applicant submits that pending dependent claims 14-17 and 19 contain all features of their respective independent claim 18. Since claim 18 should be allowed, as argued hereinabove, pending dependent claims 14-17 and 19 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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